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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/456,157	12/07/1999	CARY LEE BATES	RO999-060	6052
24038	7590	06/14/2004	EXAMINER	
MARTIN & ASSOCIATES, LLC			HUYNH, CONG LAC T	
P O BOX 548			ART UNIT	
CARTHAGE, MO 64836-0548			PAPER NUMBER	
			2178	5

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/456,157

Applicant(s)

BATES ET AL.

Examiner

Cong-Lac Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-34 and 38-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-34, 38-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment filed 3/22/04 to the application filed 12/7/99.
2. Claims 10, 35-37 are canceled.
3. Claims 46-48 are added.
4. Claims 1-9, 11-34, 38-48 are pending in the case. Claims 1, 7, 11, 15, 18, 23, 27, 38, 41, 46-48 are independent claims.
5. The rejections of claims 10, 35-37 under 35 U.S.C. 101 have been withdrawn in view of the cancellation of these claims.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 6-8, 11-13, 15-16, 18-21, 23-24, 26-32, 34, 38-44 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Dinkelacker (US Pat No. 6,345,284 B1, 2/5/02, filed 6/6/97).

Regarding independent claim 18, Dinkelacker discloses:

- copying information selected by a user into the paste buffer (col 5, lines 1-13: the highlighted object is extracted and written to the buffer)

- automatically collecting and writing information relating to a source of the user selected information into the paste buffer *without further input from the user* when a user-selected information is copied into the paste buffer (col 4, line 60 to col 5, line 13: the Palette Manager passes any tags, attributes or file names selected by user through the user events and any tags and attributes that the user attaches to the extracted object are written into the buffer, figure 7, #708, #701, #712, #702; since the attributes and tags attached to the extracted object are written into the buffer based on selecting of the highlighted text by a user *where the attributes and tags are information relating to a source of the extracted object*, which is the user-selected information, the attributes and tags are written to the buffer along with the user-selected information without further input from the user)

Dinkelacker does not disclose the first field and the second field in the paste buffer for copying information selected by a user and writing information relating to a source of the user selected information when the user-selected information is copied into the paste buffer.

However, it would have been obvious to an ordinary skill in the art at the time of the invention was made to have modified Dinkelacker to include a first field and a second field in the buffer for storing the selected information and the source of the selected information for the following reason. The fact that Dinkelacker *has the capability to write the highlighted data selected by a user and the attribute or the file name attached to the extracted object to the buffer* shows that the buffer has designated portions to store the

extracted information and the attributes or file name copied into the buffer and to support the retrieving process when writing said information to the destination files (col 5, lines 1-13). In other words, it is suggested to include in the buffer various fields for storing specific data differentiated by using the "first" and the "second".

Regarding claim 19, which is dependent on claim 18, Dinkelacker discloses that the information written to the paste buffer is determined by at least on specified cut/copy preference (col 3, line 56 to col 4, line 10 and figure 4: the information written to the buffer is determined by at least on specified cut/copy preference for example a user wants to present the selected text to either a novice, an expert, or want to attach the title or the author of the source with the selected text).

As mentioned in claim 18, Dinkelacker does not disclose that the buffer includes the second field for storing the information relating to the extracted text. However, it would have been obvious to an ordinary skill in the art at the time of the invention was made to have modified Dinkelacker to include a second field in the buffer for the same reason as mentioned in claim 18.

Regarding claim 20, which is dependent on claim 18, Dinkelacker discloses:

- inserting the information in the paste buffer into a document (col 5, lines 1-13: writing the selected text in the buffer into the destination file)
- processing the information in the paste buffer to determine whether or not to automatically create a citation according to at least one specified paste

preference (col 5, lines 1-13; col 4, lines 29-37 and figure 4: writing the *file names or attributes attached to the selected text* into the destination files where the user preferences in #401 and #407 of figure 4 determine how the selected text is presented in the destination document)

- providing events of instructional content, associated with the highlighted object, as embedding the user preference when pasting object to the destination file, where the events can be created by users (col 3, line 33 to col 4, line 10)

Dinkelacker does not disclose the first field and the second field in the buffer that store the selected text and the source of the selected text to be pasted into a destination document.

However, it would have been obvious to an ordinary skill in the art at the time of the invention was made to have modified Dinkelacker to include a first field and a second field in the buffer for storing the selected information and the source of the selected information for the reason mentioned in independent claim 18 above.

Dinkelacker also does not disclose automatically creating a citation according to the paste preference.

However, it would have been obvious to an ordinary skill in the art at the time of the invention was made to have modified Dinkelacker to include creating a citation according to the paste preference for the following reason. Dinkelacker provides the author name as well as the file name of the document source of the selected portion as the user preference for pasting. The information of the source of the selected text and the *possibility of event creation of users* Dinkelacker, therefore, suggests to create a

citation in the destination file since a user *can include an event of creating a citation as desired* based on the author name and the file name (of the document) which are well-known as the elements of a citation.

Regarding claim 21, which is dependent on claim 18, Dinkelacker does not disclose that the citation comprises a parenthetical citation that is inserted in the document after the information in the first field that is inserted into the document.

However, Dinkelacker does suggest creating a citation based on the possibility that a user can create instructional events associated with the selected object as mentioned in claim 20 above.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Dinkelacker to *include the event of creating a parenthetical citation for a selected object instead of a general citation* based on the possibility of creating a desired event.

Regarding independent claim 23, Dinkelacker discloses:

- inserting the information in the paste buffer into a document (col 5, lines 1-13: writing the selected text in the buffer into the destination file)
- processing the information in the paste buffer to determine whether or not to automatically create a citation according to at least one specified paste preference (col 5, lines 1-13; col 4, lines 29-37 and figure 4: writing the *file names or attributes attached to the selected text* into the destination files where

the user preferences in #401 and #407 of figure 4 determine how the selected text is presented in the destination document)

- providing events of instructional content, associated with the highlighted object, as embedding the user preference when pasting object to the destination file, where the events can be created by users (col 3, line 33 to col 4, line 10)

Dinkelacker does not disclose the first field and the second field in the buffer that store the selected text and the source of the selected text to be pasted into a destination document.

However, it would have been obvious to an ordinary skill in the art at the time of the invention was made to have modified Dinkelacker to include a first field and a second field in the buffer for storing the selected information and the source of the selected information for the following reason. The fact that Dinkelacker has the capability to write the highlighted data selected by a user and the attribute or the file name attached to the extracted data to the buffer shows that the buffer has designated portions to store the extracted information and the attributes or file name and to support the retrieving process when writing such information to the destination files (col 5, lines 1-13). In other words, it is suggested to include in the buffer the different fields for storing specific data into the buffer.

Dinkelacker also does not disclose automatically creating a citation according to the paste preference.

However, it would have been obvious to an ordinary skill in the art at the time of the invention was made to have modified Dinkelacker to include creating a citation

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according to the paste preference for the following reason. Dinkelacker provides the *author name as well as the file name* of the document source of the selected portion as the user preference for pasting. The information of the source of the selected text and the *possibility of event creation of users* Dinkelacker, therefore, suggests to create a citation in the destination file since a user *can include an event of creating a citation as desired* based on the author name and the file name (of the document) which are well known as the elements of a citation.

Claim 24 includes the same limitations as in claim 21, and is rejected under the same rationale.

Regarding claim 26, which is dependent on claim 23, Dinkdelacker suggests that the information stored in the paste buffer relates to a source for the selected information copied into the buffer as mentioned in claim 23.

Claims 27-32, 34 are for a program product of method claims 18-21 and 23-24, and are rejected under the same rationale.

Claims 1-4 are for a system of method claims 18-21, and are rejected under the same rationale.

Regarding claim 6, and its corresponding program product claim 34, Dinkelacker discloses that the cut/copy mechanism and the paste mechanism are different portions of the same copy/paste mechanism (col 1, lines 29-50).

Claims 7-8 are for an apparatus for performing method claims 20-21 and 23-24, and are rejected under the same rationale.

Claims 11-13 are for an apparatus for performing method claims 18-21 and 23-24, and are rejected under the same rationale.

Claims 15-16 include the limitations of claims 11-13, and are rejected under the same rationale.

Claims 38-40 are for a program product of method claim 18 and system claim 1, and are rejected under the same rationale.

Claims 41-44 are for a program product of method claims 20-21, and are rejected under the same rationale.

8. Claims 5, 9, 14, 17, 22, 25, 33, 45 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Dinkelacker as applied to claims 3 and 18 above, and further in view of Nielsen (US Pat No. 6,199,071 B1, 3/6/01, filed 4/1/97).

Regarding claim 22, which is dependent on claim 18, Dinkelacker does not disclose that the citation comprises a footnote citation comprising a footnote reference number and footnote text, wherein the footnote reference number is inserted in the document after the information in the first field that is inserted into the document, and wherein the footnote text is placed in a different location in the document.

Nielsen discloses that the citation comprises a footnote citation comprising a footnote reference number and footnote text, wherein the footnote reference number is inserted in the document after the information in the first field that is inserted into the document, and wherein the footnote text is placed in a different location in the document (col 6, line 29 to col 7, line 3; figure 4, #409, #411; col 11, line 58 to col 12, line 15; figures 9a-b).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined the Nielsen's footnote citation into the Dinkelacker's pasted information for the following reason. Nielsen discloses generating a footnote citation including a footnote reference number and footnote text where the footnote reference number is placed next to the text in the document that needs to be referred to and footnote text is placed in a different location in the document providing the advantage to utilize the *selected text pasted in the destination document as a particular text that needs to be referred to* for inserting the footnote reference number and to utilize the attributes and the file name *associated with the selected text* and pasted to the destination file as the information *referred from the footnote number*.

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Claim 25 includes the same limitations as in claim 22, and is rejected under the same rationale.

Claims 33 and 45 are for a program product of method claim 22, and are rejected under the same rationale.

Claim 5 is for a system of method claims 22 and 25, and is rejected under the same rationale.

Claims 9 and 14 are for an apparatus for performing method claims 22 and 25, and are rejected under the same rationale.

Claim 17 includes the same limitation as in claim 14, and is rejected under the same rationale.

9. Claims 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dinkelacker (US Pat No. 6,345,284 B1, 2/5/02, filed 6/6/97) in view of Nielsen (US Pat No. 6,199,071 B1, 3/6/01, filed 4/1/97).

Regarding independent claim 47, Dinkelacker discloses:

- inserting the information in the first field of the paste buffer into a document (col 5, lines 1-13: writing the selected text in the buffer into the destination file)

Dinkelacker does not disclose:

- automatically creating from the information in the second field of the paste buffer a footnote in the document, wherein the footnote comprises a footnote reference number and corresponding footnote text, wherein the footnote reference number is inserted in the document after the information in the first field is inserted in the document, and wherein the corresponding footnote text is placed in a different location in the document

Nielsen discloses creating a footnote in a document from the information in a field of the paste buffer, wherein the footnote comprises a footnote reference number and corresponding footnote text, wherein the footnote reference number is inserted in the document after the information is inserted in the document, and wherein the footnote text is placed in a different location in the document (col 6, line 29 to col 7, line 3, figure 4, #409, \$11, col 11, line 58 to col 12, line 15, figures 9a-b).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined the Nielsen's footnote citation into the Dinkelacker's pasted information for the following reason. Nielsen discloses generating a footnote citation including a footnote reference number and footnote text where the footnote reference number is placed next to the text in the document that needs to be referred to and footnote text is placed in a different location in the document providing the advantage to utilize the *selected text pasted in the destination document as a particular text that needs to be referred to* for inserting the footnote reference number and to

utilize the attributes and the file name *associated with the selected text* and pasted to the destination file as the information *referred from the footnote number*.

Claims 46 and 48 are for an apparatus and a program product of method claim 47, and are rejected under the same rationale.

Response to Arguments

10. Applicant's arguments filed 3/22/04 have been fully considered but they are not persuasive.

Applicants argue that Dinkelacker does not disclose automatically collecting and writing information relating to a source of the user-selected information in the paste buffer without further input from the user when the user-selected information is written to the first field (Remarks, page 17).

Examiner respectfully disagrees.

Dinkelacker discloses that the Palette Manager passes any tags, attributes or file names selected by user through the user events and any tags and attributes that the user attaches to the extracted object are written into the buffer (col 4, line 60 to col 5, line 13, figure 7, #708, #701, #712, #702. Since the attributes and tags attached to the extracted object are *written into the buffer based on selecting of the highlighted text by a user* where the attributes and tags are information relating to a source of the extracted object, which is the user-selected information, the attributes and tags are written to the

buffer, actually to the portions of the buffer equivalent to the fields of the buffer, along with the user-selected information without further input from the user.

Applicants argue that Dinkelacker does not disclose determining whether or not to automatically create a citation according to at least one paste preference (Remarks, pages 18-19).

Examiner does not agree completely.

Dinkelacker discloses writing the *file names or attributes attached to the selected text* into the destination files (col 5, lines 1-13; col 4, lines 29-37) based on the events in #401 and #407 of figure 4 to *determine how the selected text is presented in the destination document* (col 3, lines 33-67).

Dinkelacker provides the *author name as well as the title* of the document source of the selected portion in the pasting preference (figure 4). Since the events selected can include the title and the author of the source containing the selected portion, where the title and the author are well known as the elements of a citation, it is suggested to include determining whether or not to automatically create a citation to Dinkelacker in conjunction with selecting author's name and title of the source document.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within


TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

clh
6/8/04


STEPHEN S. HONG
PRIMARY EXAMINER